

REMARKS

Applicant cancelled claim 228 without prejudice or disclaimer of its subject matter, amended claim 221, and added new claims 259-262 to further define Applicant's claimed invention. The amendment to claim 221 is supported at least by Fig. 15 and former claim 228. New claims 259 and 262 are supported at least by Figs. 1 and 2. New claims 260 and 261 are supported at least by Fig. 15.

In the Office Action, the Examiner provisionally rejected all of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the claims of Applicant's co-pending Application No. 10/808,852. The Examiner indicated that upon the submission of a proper Terminal Disclaimer, claims 126-130, 207-220, and 236-257 are allowed, and that claim 235 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Applicant is submitting concurrently with this Reply a Terminal Disclaimer of the terminal part of any patent granted in the present application which would extend beyond the expiration of Application No. 10/808,852. Applicant submits that the provisional obviousness-type double patenting rejection has been overcome.

The Examiner rejected claims 221-225, 227-234, and 258 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,482,233 to Aebi et al. ("Aebi"). Applicant respectfully traverses the Examiner's rejection. Claim 221 recites a method for forming an interbody spinal fusion implant, including the step of forming a plurality of surface projections, at least two of the surface projections having a forward facet and a rearward facet, "said rearward facet terminating at a first location proximate the base, said rearward facet terminating at a second location proximate said forward facing facet, the first location being closer to the leading end of the implant than the second location."

Aebi teaches an implant 10 having a plurality of spikes 28, the anterior side of each spike being slanted at an angle B which ranges "from about 0 degrees to 30 degrees." (Aebi, col. 4, lines 39-41; Fig. 6). Aebi does not teach or suggest a method for forming an implant as recited in independent claim 221.

Applicant respectfully disagrees with the Examiner's contention that Aebi discloses both the forward facet and the rearward facet having "a negative inclination which produces a portion that extend outside the perimeter of a base portion or 'said rearward facet terminating at a first location proximate the base, said rearward facet terminating at a second location proximate said forward facet, the first location being closer to the leading end [sic] of the implant than the second location (claim 221).'" (See Office Action, page 4, paragraph 1). Applicant further respectfully disagrees with the Examiner's contention that the angles for the steeper angled face disclosed by Aebi as being "from about 0 to about 30 degrees" can "include negative angles." (Office Action, page 4, paragraph 1). Applicant assumes the Examiner is referring to angle B in Fig. 6, described by Aebi at col. 4, lines 39-41. There is no teaching or suggestion in Aebi for angle B to be less than 0 degrees. In Fig. 6 of Aebi, the range of angle B is marked by left and right arrows to either side of the range. The left arrow at the lower end of the range is pointing to the right, indicating that the lower end of the range is at the right of the arrow, i.e., "0 degrees or more." All angles taught by Aebi for the rearward facet are positive.

Under the "Response to Arguments" section of the Office Action, the Examiner stated that "[t]he Examiner notes applicant's submission of the restriction requirement made in 09/457,228; it is unclear how this changes the teachings of Aebi et al wherein about zero would inherently include a negative and positive range." (Office Action, page 2, paragraph 2). Applicant submitted the restriction requirement to show the Examiner's position in a related application that a rearward facet that is vertical is patentably distinct (i.e., non-obvious) from a rearward facet that has a negative angle of inclination.

The Examiner contends that "about 0" inherently includes negative angles. (Office Action, page 2, paragraph 2). According to the MPEP, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." (MPEP § 2163.07(a) (May 2004), quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). There is no evidence in Aebi that the term "about" is meant

to cover a range on either side of zero. Fig. 6 of Aebi indicates that the range is intended to be zero or greater because of the direction of the arrow. Accordingly, Applicant submits that negative angles are not inherently disclosed by Aebi. Applicant submits that the Examiner's rejection of claims 221-225, 227-234, and 258 under 35 U.S.C. § 103(a) as being unpatentable over Aebi has been overcome.

Applicant submits that independent claim 221 is patentable and that dependent claims 221-225, 227-234, and 258-262 dependent from independent claim 221, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

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